

REMARKS

The Office Action dated September 26, 2001 has been carefully considered. Claims 1, 7-11 and 25 have been amended and claim 30 has been canceled. Claims 34-43 have been added as new claims. Claims 1-12 and 25-29, and 31-43 remain in the application. Applicant respectfully requests reconsideration and reexamination of the claims in view of the foregoing amendments and the following remarks.

As a preliminary matter, Applicant has amended the title as suggested in paragraph 2 of Office Action.

Turning to the indefiniteness rejections, Applicant does not understand the indefiniteness rejection of claim 5. Claim 5 does not include the phrase "conventional mold" as asserted by the Patent Examiner in line three as asserted in the Office Action. Therefore, Applicant respectfully requests removal of that rejection.

With respect to the indefiniteness rejections of claims 6 and 31, the rejection is respectfully traversed. The patent examiner has taken a very narrow interpretation of the word "mold". Applicant is entitled to adopt a more broad interpretation by being its own lexicographer and has properly done that by way of indicating a broad meaning for that term in the specification. Applicant's definition is not repugnant at all. As evidence, applicant submits a copy of a dictionary definition that has broader definitions of the term "mold". As contained in the enclosed dictionary definition, mold includes "a cavity in which a fluid or malleable substance is given form". Clearly applicant's lip balm jar as defined in claim 6 falls within this definition. Indeed, in the enclosed copy of dictionary pages, very simple molds are illustrated. Therefore, Applicant respectfully requests removal of the indefiniteness rejections of claims 6 and 31.

With respect to the rejection of claim 10, Applicant has amended claims 7-10 to change dependencies, provide antecedent basis and to provide consistent usage among different terms among all claims. Applicant has done so to provide a desired and different meaning to these claims, not based on patentability reasons. Applicant has also amended claims 11 and 25 as suggested by the Patent Examiner. In view of the amendments, removal of the indefiniteness rejection pertaining to claims 10, 11, and 25 is respectfully requested.

With respect to the rejections of claims 29 and 30 set forth in paragraph 5 of the Office Action, Applicant has canceled claim 30 and traverses the rejection of claim 29. Claim 29 sets forth positive limitations on how the kit is packaged. This is not "intend to" language as asserted by the Patent Examiner. In view of the cancellation of claim 30 and traversal of claim 29, Applicant solicits removal of these rejections.

With respect to the non-statutory double patent rejection advanced in paragraph 7 of the Office Action, Applicant has filed a terminal disclaimer. Therefore this rejection is now moot.

Turning to the rejections over the prior art, Claims 6 and 31 have been rejected as anticipated over Applicant's submitted prior art statement in paragraph 9. The Patent Examiner has asserted that Patent Application Serial No. 08/924,196 (now U.S. Patent No. 5,971,351) does not provide descriptive support. This is not true. Applicant respectfully references the Patent Examiner to Col. 5, lns. 65-67 of the parent patent which recites "such molds need not be in the shape of a conventional lipstick, but can be of the shape of a lip balm jar, tub or the like." Based on this proper support in the parent application/patent, Applicant solicits removal of this rejection.

Turning to the other prior art rejections, the Patent Examiner has asserted that claims 1-12 and 25-33 are both anticipated and obvious over Collins et al (U.S. Patent No. 5,780,018). This rejection is somewhat confusing to the Applicant. If the claims are anticipated, then there is no missing limitations or elements which would necessitate an obvious rejection. In other words, a claim may be either obvious or anticipated over a single reference, but not both. Nevertheless, it is well settled law under either legal standard that all claim limitations and elements must be explicitly disclosed (as per an anticipation rejection) or otherwise taught or suggested in the prior art (as per an obviousness rejection).

In this regard, Applicant has amended the independent claims to include limitations which are clearly not disclosed, taught or suggested by the teachings of Collins. In particular, claim 1 now recites the further limitation that "wherein the plurality of containers, the measuring means, and the mold are packaged together in the kit for resale at the point of purchase with the at least one base and the pigments stored separately in the containers". Along similar but not identical lines, claim 25 now recites the further limitation that "wherein said plurality of pigments are stored separately from the at least one base and packaged

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together along with at least one measurer and the mold in the kit for resale at a point of purchase."

In paragraph 12, the patent examiner relies upon language from Collins that relates to manufacture of the pellets. However, Collins teaches a kit that comprises differently colored pellets in which the pigments and the base are already mixed by the manufacturer, not "stored separately" as in now claimed. (See e.g. Col. 2, lns. 27-38 which recite that the pellets comprise only 10-35% pigment, with the remainder in oil/wax materials). Thus, the pellets are formed and the pigments and base intermixed in the pellets at the manufacturer, not at the point of purchase.

Further, as is now claimed, the pigments and bases must not only be stored separately, but also packaged together in a kit for resale along with the measuring device and mold. This is not taught, suggested or disclosed anywhere in Collins.

Applicant has added claims 34-43. It is believed that these claims further define additional structure and limitations which are not disclosed, taught or suggested by Collins. Applicant respectfully requests the Patent Examiner to consider the patentability of these new claims over the prior art of record.

CONCLUSION

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class mail in an envelope addressed to: Commissioner for Patents, BOX NON FEE AMENDMENT, Washington, D.C. 20231.

Date: November 20, 2001


